

RemarksApplication Status and Disposition of Claims

This Amendment responds to the non-final Office Action mailed June 25, 2010. In the Action, the Office considered claims 3-5 and 10.

With this amendment, Applicants do not amend, cancel, or add any claims. Thus, claims 3-5 and 10 remain pending and under consideration.

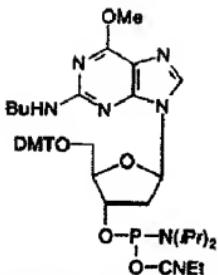
Claim Rejections – 35 U.S.C. § 112, First Paragraph

The Office Action rejects claims 3-5 and 10 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Office Action asserts that Applicants were not in possession of 6-O-methyl-d'-deoxyguanosine, apparently because the structure shown on page 6 of the specification, which is labeled as "O6-Me-2'-deoxyGuanosine," is not actually 6-O-methyl-d'-deoxyguanosine. Applicants disagree with the rejection for the reasons that follow.

Initially, so that there is no confusion about the passage referred to by the Office on page 6 of the specification, Applicants reproduce it (and the paragraph that precedes it, so that its context can be seen):

The polynucleotide of the present invention can be produced by methods known to persons skilled in the art, such as the gene recombination technique, the nucleic acid synthesis, or the site-directed mutagenesis. For example, a polynucleotide or a polynucleotide derivative may directly be synthesized using a DNA synthesizer, in accordance with the nucleic acid synthesis that is generally used in genetic engineering. A portion of such a polynucleotide may be synthesized, and it may be then amplified by the PCR method or using a cloning vector or the like. Moreover, as mentioned above, in order to obtain a polynucleotide derivative that is stable in cells, a base, a sugar, and a phosphoric acid portion may chemically be modified. Examples of the aforementioned polynucleotide synthesis method may include the phosphate triester method, the phosphoramidite method, and the H-phosphonate method.

A polynucleotide wherein guanosine is methylated at position 6 may be produced using the following compound as a starting material, for example:

***O6-Me-2'-deoxyGuanosine***

It is clear from reading this passage in context that the structure shown is a starting material that can be used to make a polynucleotide wherein guanosine is methylated at position 6. It is also clear from reading this passage in context that Applicants do not intend to identify 6-O-methyl-d'-deoxyguanosine by this structure. Thus, the rejection finds no support in this passage.

Applicants also respectfully note that 6-O-methyl-d'-deoxyguanosine has a defined meaning in the art, which would be well known to those of ordinary skill. Applicants further respectfully note that there is nothing in the specification to suggest that Applicants intended to define the term 6-O-methyl-d'-deoxyguanosine as anything other than what it would be known to be in the art. Thus, when 6-O-methyl-d'-deoxyguanosine is used in the specification, it is intended to mean exactly what a person of ordinary skill in the art would understand it to mean.

Additionally, with respect to this point, Applicants note that a specification need not (and preferably should not) disclose that which is known to those of ordinary skill (MPEP 2164.05(a)). There is no requirement that Applicants disclose the structure of 6-O-methyl-d'-deoxyguanosine, as that structure would be well known to those of ordinary skill. Thus, to the extent that the rejection is based on the failure to show the structure of 6-O-methyl-d'-deoxyguanosine (see the sentence spanning pages 2-3 of the Office Action), the rejection is misplaced.

Finally, Applicants note that the Examples show that the claimed invention was actually reduced to practice. See, for example, the sentence at page 9, lines 13-14, which states that “[i]n the test example . . . mG represents O6-methyl-2'-deoxyguanosine.” Thus, it is clear from the Examples that a polynucleotide comprising “O6-methyl-2'-deoxyguanosine” was actually tested. Applicants submit that this is evidence that Applicants were in possession of the claimed invention.

Applicants respectfully submit that, at worst, page 6 of the specification is somewhat confusing due to the apparent labeling of the starting material structure shown on that page. (Applicants maintain that when read in context, it is quite clear what is meant, and that the specification is not confusing.) However, Applicants submit that if the Office believes that the specification is confusing, that the issue can easily be remedied by deleting the “O6-Me-2'-deoxyGuanosine.”

CONCLUSION

In view of the foregoing remarks and amendments, Applicants respectfully request withdrawal of the objection and rejections of record and allowance of the claims. If the Examiner has any questions or wishes to discuss this application further, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

The Patent and Trademark Office is hereby authorized to charge Deposit Account No. 19-0089 any fee necessary to ensure consideration of the submitted materials.

Respectfully Submitted,
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